



**UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/082,328	06/24/93	KNIGHT	T 7828003

PENNIE & EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036-2711

MM51/1210

EXAMINER

SPARKS, D

ART UNIT	PAPER NUMBER
2835	30

DATE MAILED: 12/10/98

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
08/082,328

Applicant(s)  
Knight et al.

Examiner  
Donald A. Sparks

Group Art Unit  
2835



☒ Responsive to communication(s) filed on Nov 5, 1998

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1, 28, 37-48, 52-59, 102, 143, 144, 146, and 147 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☒ Claim(s) 44 and 59 is/are allowed.

☒ Claim(s) 1, 28, 37-43, 45-48, 52-58, 102, 143, 144, 146, and 147 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 29

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 2835

### **DETAILED ACTION**

The request filed on November 5, 1998 by Express Mail for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/082,328 is acceptable and a CPA has been established. An action on the CPA follows.

The examiner acknowledges the applicants' submission of the amendment dated November 5, 1998, wherein the applicants canceled claims 2-27, 30-36, 49-51, 60-79, 103-142, 145, 148-200 and 203-209.

#### **1. INFORMATION CONCERNING DRAWINGS**

##### **Drawings**

As required by M.P.E.P. § 707.07 and M.P.E.P. § 707.07(e), the examiner reminds the applicant's of the necessary drawing corrections required by the draftsman indicated on the PTOL-948 which accompanied the office action dated March 7, 1996.

#### **2. ACKNOWLEDGEMENT OF REFERENCES CITED BY APPLICANT**

##### **Information Disclosure Statement**

As required by M.P.E.P. § 609 (C), the applicant's submission of the Information Disclosure Statement dated November 5, 1998 is acknowledged by the examiner and the cited references have been considered in the examination of the claims now pending. As required by

Art Unit: 2835

**M.P.E.P. § 609 C(2)**, a copy of the PTOL-1449 initialed and dated by the examiner is attached to the instant office action.

### **3. REJECTIONS BASED ON PRIOR ART**

#### **Claim Rejections - 35 USC § 102**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

-- Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 5,103,283 awarded to Hite.

The “**substrate**” is represented by element 2. The “**chip**” is represented by element 10. The “**means for powering the chip**” is represented by the inherent external structure connected to element 4 to provide power to the chip. The “**means for capacitively signaling between the chip and the substrate**” is represented by element 34 or 36. The “**signal leads connected on the substrate and the chip**” are represented by elements 38 and 40.

-- Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,982,311 awarded to Dehaine et al.

Art Unit: 2835

The “substrate” is represented by element 16. The “chip” is represented by element 12. The “means for powering the chip” is represented by element 15. The “means for capacitively signaling between the chip and the substrate” is represented by element 19. The “signal leads connected on the substrate and the chip” are represented by elements 18b and 38.

-- Claims 1 are rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Pat. No. 4,982,311 awarded to Japanese ref.(63-15435).

The “substrate” is represented by element 1. The “chip” is represented by element 5. The “means for powering the chip” is represented by at least one of the elements 3. The “means for capacitively signaling between the chip and the substrate” is represented by element 7. The “signal leads connected on the substrate and the chip” are represented by the traces on the substrate which connect to element 7' and the bonding pad on the active surface of the chip.

-- Claims 1, 28, 37-39, 41-43, 47, 52-58, 102, 143, 144, 146 and 147 are rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over U.S. Pat. No. 5,404,265 awarded to Moresco et al.

The “substrate” is represented by element 20. The “chip” is represented by element 10. The “means for powering the chip” must inherently exist and is represented by what ever power supply system that is connected to element 20 to provide power to the chip (10). The “means for capacitively signaling between the chip and the substrate” is represented by the combination of elements 30', 40' and 50' where element 30' and 40' represent the first and second half capacitors. The “signal leads connected on the substrate and the chip” is

Art Unit: 2835

represented by the traces on the substrate which connect to element 40' and the bonding pad on the active surface of the chip which is below element 30'.

**:IMPORTANT NOTE:**

The 5,404,265 reference is a U.S. patent awarded to Moresco et al. that claims the rejected invention. An affidavit or declaration is inappropriate under 37 CFR 1.131(a) when the patent is claiming the same patentable invention, see MPEP § 2306. The patent can only be overcome by establishing priority of invention through interference proceedings. See MPEP Chapter 2300 for information on initiating interference proceedings.

**Claim Rejections - 35 USC § 103**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

-- Claims 40, 45, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Pat. No. 5,404,265 awarded to Moresco et al.

Claims 40, 45, 46 and 48 define over the structure of Moresco et al. (5,404,265) by the requirement that **portions of the chip are passivated and securely fastened together**. It is an expedient in the art to provide a **passivation layer on the bottom surface of the chip adjacent**

Art Unit: 2835

to elements 30 for the purpose of limiting the flow of solder and preventing the contacts from shorting together during the bonding process. Furthermore, to use an adhesive material for the dielectric would also have been within the skill of a practitioner in the art in an effort to prevent the half capacitor from separating from one another.

**4. ACKNOWLEDGMENT OF ISSUES RAISED BY THE APPLICANT**

**Response to Amendment**

Applicant's arguments filed February 25, 1998 have been fully considered but they are not deemed to be persuasive and, as required by M.P.E.P. § 707.07(f), a response to these arguments appears below.

**a. ARGUMENTS CONCERNING FORMAL MATTERS**

The applicant's traversal of the formal requirements requested by the examiner are addressed in the following section as required by M.P.E.P. § 707.07(f).

**:IMPORTANT NOTE:**

As this action constitutes a final rejection, applicant's response must either comply with all formal requirements or specifically traverse each requirement not complied with. The examiner further draws the applicant's attention to 37

Art Unit: 2835

**C.F.R. § 1.113 and 37 C.F.R. § 1.116** regarding the submission of after-final responses and amendments.

**5. CLOSING COMMENTS**

**Conclusion**

**a. STATUS OF CLAIMS IN THE APPLICATION**

The following is a summary of the treatment and status of all claims in the application as recommended by **M.P.E.P. § 707.07(I)**:

**a(1) SUBJECT MATTER CONSIDERED ALLOWABLE**

Claims 44 and 59 have been allowed.

**a(2) CLAIMS NO LONGER IN THE APPLICATION**

Claims 2-27, 29-36, 49, 50, 51, 60-101, 103-142, 145 and 148-209 have been canceled.

**a(3) CLAIMS REJECTED IN THE APPLICATION**

Applicant's amendment did not necessitate a new ground(s) of rejection presented in this Office action and the previous rejections are still applicable.

Accordingly, **THIS ACTION IS MADE FINAL ON FIRST ACTION**. See **MPEP**



Art Unit: 2835

**§ 706.07(a).** Applicant is reminded of the extension of time policy as set forth in **37 CFR 1.136(a).**

A shortened statutory period for response to this final action is set to expire **THREE MONTHS** from the date of this action. In the event a first response is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to **37 CFR 1.136(a)** will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than **SIX MONTHS** from the date of this final action.

For at least the above reasons it is the examiner's position that the applicant's claims are not in condition for allowance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald A. Sparks whose telephone number is (703) 308-1756. The examiner can normally be reached on **Mon. thru Fri.** from **6:30 A.M.** to **3:00 P.M.**.

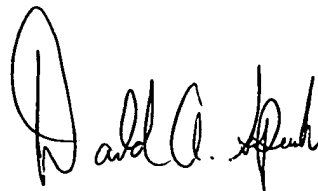
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Leo P. Picard, can be reached on (703) 308-0538. The fax phone number for this Group is (703) 305-3431 or 3432.

Application/Control Number: 08/082,328

Page 9

Art Unit: 2835

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-1782.

A handwritten signature in black ink, appearing to read "Donald A. Sparks". The signature is stylized with a large initial "D" and a cursive "A".

**Donald A. Sparks**  
**Primary Examiner**  
**Art Unit 2835**

December 8, 1998